

Remarks

Information Disclosure Statement

The Office Action states that the Information Disclosure Statement filed 10/27/2006 fails to comply with 37 CFR 1.98(a)(3) because a EP search report 06014143.9 was provided in German and a concise explanation in English language of the relevance thereof was not provided.

In addition, the Office Action states the Information Disclosure Statement failed to list references cited in the specification.

A supplemental Information Disclosure Statement was filed separately to cure these defects on May 18, 2009. Entry and consideration of the above indicated references of said supplemental Information Disclosure Statement is therefore respectfully requested.

Drawings

The Office Action objects to the Drawings under 37 CFR 1.84(p)(5) as failing to include reference signs 28 (cutting web), 11 (gripper) and 34 (gripping jaws) in Figs. 3a/b.

Applicant hereby provides a replacement sheet with corrected Figs. 3a/3b.

Applicant would like to keep the same references for the cutting web and gripper in Fig. 2a/b and Fig. 3a/b.

Applicant respectfully submits that holes of the top/middle/bottom plates in Fig. 5a/b are substantially the same. On page 9, lines 24 to 25 the specification indicates that holes 43 in the top/bottom plates "have substantially the same shape, size and pattern". Applicant would therefore like to keep the same reference for these holes in Figs. 5a/b.

Reconsideration and withdrawal of the objection to the Drawings under 37 CFR 1.84(p)(5) is respectfully requested in view of the above.

### Specification

The Office Action requested clarification of the passage of page 7, starting line 30. The unclear original wording arose from an inaccurate translation from German language. Applicant herewith provides a correction of this passage with an amendment in the specification as indicated with the replacement passage hereinabove. It is now clear that the reaction vessels of the type "microtube 1.5 ml", not the device of the invention, were available as provided by the company Sarstedt and distributed under item numbers SAR-72692 and SAR-62692005 at the time the application was filed.

### Claims

Following the Examiner's suggestions, claim 1 is amended to add "a" in line 3 and claim 6 is amended to delete the objected term "somewhat". These amendments are made for clarity purposes and are not meant to limit the claims.

### Claim Rejections under 35 U.S.C. § 102(b)

The Office Action rejects claims 1-5 under 35 U.S.C. § 102(b) over Burt et al. (US4674340) and over Besnier (US5533407).

Applicant respectfully submits that both documents fail to disclose opening and closing reaction vessels through frictional contact.

In column 3, lines 51-56, Burt et al. discloses a device wherein edges 88 located between serrations on the threaded cap actuate opening (closing is not mentioned). In other words, caps are fitted with serrations and edges 88 of the gripping device engage these serrations. This fails to meet the limitations of claim 1 which requires that "when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact". In Burt et al. the mechanical engagement of the edges 88 between the serrations on the threaded cap is distinct from the frictional contact required by the wording of claim 1. Therefore, Burt et al. fails to teach a device that anticipates the device of claim 1.

As for Besnier, it discloses an active gripping device with pivoting noses 108 for gripping of the jug's cap. Tightening/loosening of the pivoting noses 108 is controlled by vertical displacement

of yoke 112 by screwing on threaded rod 109 (see in particular yoke 112 and pivoting nose 108 in Fig. 6 in Besnier). Column 7, lines 28-47 of Besnier describes the interaction of yoke 112 trapped between the noses 108 by displacement of yoke 112. Thus, opening/closing of caps is done by a gripper which is an active operating device composed of noses 108 which are tightened/loosened around the cap and rotated for opening/closing of the jug. Conversely, the wording of claim 1 specifically excludes gripper having active operating device.

The wording of claim 1 further requires that: "when the lid is inserted into the area between the gripper jaws, it is held by the gripping jaws through frictional contact". Besnier fails to teach a device that meets this requirement. Besnier teaches a device in which the cap of the jug is held by the gripper through tightening of the noses 108. The tightening of the noses 108 is a mechanical actuation distinct from not frictional contact. Therefore, Besnier does not teach a devices that anticipates the device of claim 1.

Reconsideration and withdrawal of the rejections of claims 1-5 under 35 U.S.C. § 102(b) over Burt et al. (US4674340) and over Besnier (US5533407) under is therefore respectfully submitted.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Office Action rejects claims 6-11 under 35 U.S.C. § 103(a) over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684).

The Office Action states that, regarding claims 6-8 and 11, Burt et al. / Besnier disclose all of the limitations. Applicant respectfully disagrees for the reasons given hereinabove. As explained above, both Burt et al. and Besnier fail to teach opening and closing reaction vessels through frictional contact. In addition Besnier discloses a gripper having an active operating device. Therefore there is no teaching of the claimed device in the prior art of records.

The Office Action acknowledges that Burt et al. and Besnier fail to teach the holding device claimed in claims 6-11. The Office Action further states that Marino discloses a holding apparatus for holding resilient plastic tubes comprising the limitations of the device of claim 6.

In fact, as explained above, one of the main differences with the devices taught by Burt et al./Besnier is that when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact.

There is no suggestion in Burt et al./Besnier and Marino to modify the device of Burt et al./Besnier to have gripping jaws holding the lids through frictional contact.

There is no motivation to modify the opening/closing system of Besnier/Burt et al. to conform the opening/closing system of the device of the invention either. In fact, the devices taught in Besnier/Burt et al. work according to different principles of operation.

The principle of operation of the device taught by Besnier is that a cap is removed and put back in place on the jug by active mechanical means (tightening/loosening of gripper noses 108) that can be actuated and controlled. With this configuration, the cap can be removed and put back in place depending on the actuation of the gripping jaws. A modification of the device taught in Besnier to have the caps removed by gripping jaws wherein they are held by frictional contact would not be seen as advantageous because it would mean losing the control of the gripping jaws. Therefore, there would be no motivation to replace the active gripping means of the device of Besnier by the non active gripping means of the invention and the device of the invention cannot be considered as obvious over Besnier.

The device taught by Burt et al. requires caps with serrations that are only meant to be unscrewed and not put back in place on the recipients. Once the caps are unscrewed, they fall from the hollow cup shaped device which is then empty and ready for unscrewing the next recipient. The fact that a cap may be stuck in the hollow cup shaped device is highly unwanted, because it would not allow unscrewing the next recipient. Conversely, in the device according to the invention, the lids are held in the gripper jaws by frictional contact and stay in place until they are screwed back on the vessels. They are not discarded. Therefore, replacing the hollow cup shaped device of Burt et al. by the gripper jaws of the device according to the invention would render the device of Burt et al. so modified unsatisfactory for its intended purpose, because it would no longer allow unscrewing recipients after the first recipient is unscrewed. The gripper would be obstructed by a lid held in place by frictional contact and would not be able to unscrew yet another recipient. MPEP 2143.01.V states that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, there would be no motivation to

modify the device taught by Burt et al. and the device of the invention cannot be considered as obvious over Burt et al.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 6-11 under 35 U.S.C. § 103(a) over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684).

The Office Action also rejects claims 9 and 10 under 35 U.S.C. § 103(a) over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684), and further in view of Hansen et al. (US2003/0038071).

Claims 9 and 10 depend on claim 6 and the remarks made with regard to claim 6 over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684) also apply to claims 9 and 10.

Hansen et al. does not cure the defects of Burt et al. and Besnier. Therefore, claims 9 and 10 cannot be considered as obvious over these references either.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6-11 under 35 U.S.C. § 103(a) over Burt (US4674340) or Besnier (US5533407) in view of Marino (US6132684) and further in view of Hansen et al. (US2003/0038071).

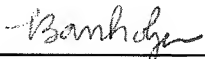
### Conclusion

Pending claims are believed to be in condition for allowance and issuance of a Notice of Allowance is respectfully requested. No fee is believed to be due at this time, however, the Commissioner is authorized to charge any fee deficiency, or credit any overpayment, to Deposit account No. 50-0812.

If the Examiner believes that a telephone conference would expedite prosecution of this application, he is asked to telephone the undersigned directly at 925-730-8565.

Respectfully submitted,

Date: May 29, 2009

  
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